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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,684	09/05/2003	Jeff Miller	HALB:045	8556
7590 10/19/2007				
Karen B. Tripp Attorney at Law PO Box 1301 Houston, TX 77251-1301				
			EXAMINER KUGEL, TIMOTHY J	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 10/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/656,684

Applicant(s)

MILLER ET AL.

Examiner

Timothy J. Kugel

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5,9-12,30,31 and 33-35 is/are allowed.
- 6) ☒ Claim(s) 1,6-8,13-28 and 32 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-35 are pending as amended on 19 January 2007.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 January 2007 has been entered.
3. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office action.
4. The indicated allowability of claims 16-20, 22, 25 and 32 is withdrawn in view of the newly cited rejections, which follow.

### ***Response to Arguments***

5. Applicant's arguments filed 19 January 2007 have been fully considered but they are not persuasive.

Applicant's arguments regarding the mineral oil taught by Dymond are moot in view of the new ground of rejection cited below.

Applicant further argues that Dymond has no example without a fluid loss control agent; however, exemplification is not required to show anticipation. Dymond makes no teaching that a fluid loss control agent is required, listing only the copolymers in the invert emulsion as required components of the composition and therefore anticipates the composition.

### ***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: support for the subject matter of claim 29 is found only in the original claims.

### ***Claim Objections***

7. Claim 28 is objected to because of the following informalities:

Claim 28 recites the limitation "in a ratio ranging from about a 99:1 to about 60:40" and should recite, "in a ratio ranging from about a 99:1 to about 60:40" and

Claim 28 further recites the limitation "about 25% to 99.95% weight" and should recite, "about 25% to 99.95% by weight".

Appropriate correction is required.

8. Claim 29 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. Claim 30, from which claim 29 depends, requires the polymer to comprise at least two monomers—a greater amount of a polar hydrophobic monomer and a lesser amount of a hydrophilic monomer—yet claim 29 allows the polymer to be 100% of a single monomer.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 USC 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 28 is rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 28 recites the limitation “in a ratio ranging from about 99:1 to about 60:40” in regards to the ratio of the 2-ethylhexyl acrylate to acrylic acid; there is no support in the original disclosure or claims for the endpoint ratio 60:40.

Claim 28 further recites the limitations “about 25% to about 99.95% (by) weight polar hydrophobic monomers and about 0.05% to about 20% by weight hydrophilic monomers”; there is no support in the original disclosure or claims for either range.

Claim 28 still further recites the limitations "particles of the copolymer have a hydrophilic coating"; there is no support in the original disclosure or claims for either copolymer particles or coated particles.

These are new matter rejections.

The following is a quotation of the second paragraph of 35 USC 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 14-25, 27 and 32 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14-25, 27 and 32 are rejected under 35 USC 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

Regarding claims 14-25 and 32, the omitted steps are: steps relating to drilling in a subterranean formation.

Regarding claim 27, the omitted steps are: steps related to making the drilling fluid claimed.

***Claim Rejections - 35 USC § 102 and/or 35 USC § 103***

11. Claims 14, 15, 21, 23 and 26 are rejected under 35 USC 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over US Patent 4,777,200 (Dymond hereinafter).

Dymond teaches an invert emulsion (Abstract) drilling fluid (Column 1 Lines 8-14) within the scope of the present invention, which comprises copolymers having 25 to 100% of a polar hydrophobic monomer (Abstract and Column 6 Lines 40-63) such as the claimed 2-ethylhexyl acrylate (Column 7 Lines 19-23) and 0 to 20 % of a hydrophilic monomer (Column 7 Lines 19-23) such as acrylic acid (Column 7 Lines 56-64) and that the copolymer may be in the form of particles coated with a hydrophilic coating (Column 7 Lines 23-33). Since the fluids may be used as drilling fluids, the use of "consisting essentially of" cannot distinguish.

Since Dymond teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the progressive gel and stress build behavior, suspension, fluid loss control, filtration control, thickening, yield and sag behavior and viscosity of the Dymond composition would inherently be the same as claimed. If there is any difference between the product of Dymond and the product of the instant claims the difference would have been minor and obvious.

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 USC 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 USC 103 and for anticipation under 35 USC 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

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12. Claims 1, 6-8, 13, 24, 27 and 28 are rejected under 35 USC § 103(a) as being unpatentable over Dymond as applied to claims 14, 15, 21, 23 and 26 above in view of US Patent 6,006,831 (Schlemmer hereinafter).

Dymond teaches an invert emulsion drilling fluid within the scope of the present invention, which comprises copolymers having 25 to 100% of a polar hydrophobic monomer such as the claimed 2-ethylhexyl acrylate and 0 to 20 % of a hydrophilic monomer such as acrylic acid and that the copolymer may be in the form of particles coated with a hydrophilic coating.

Dymond, while teaching mineral oil does not disclose expressly the use of a synthetic oil.

Schlemmer discloses a wellbore treatment fluid comprising any of aliphatic or aromatic mineral oils or synthetic hydrocarbons such as paraffins or olefins (Schlemmer Column 8 Lines 55-67).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace the mineral oil taught by Dymond with the synthetic paraffins or olefins of Schlemmer. The motivation to do so would have been the teaching of Schlemmer that they are functional equivalents.

Since Dymond and Schlemmer combine to teach the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the progressive gel and stress build behavior, suspension, fluid loss control, filtration control, thickening, yield and sag behavior and viscosity of the Dymond/Schlemmer composition would intrinsically be the same as claimed. If there is



any difference between the product of Dymond and Schlemmer and the product of the instant claims the difference would have been minor and obvious.

***Allowable Subject Matter***

13. Claims 2-5, 9-11, 30, 31 and 33-35 are allowed for the reason of record.

Claim 32 would be allowable, for the reason of record, if rewritten to overcome the rejection under 35 USC 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

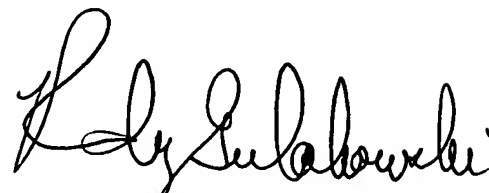
15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/TJK/

Patent Examiner, AU 1796

A handwritten signature in black ink, appearing to read "Randy Gulakowski". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

RANDY GULAKOWSKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700